



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,803	12/19/2000	Gary R. McLuen	NEI-00104	7285
28960 7590 03/21/2007 HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			EXAMINER HANDY, DWAYNE K	
			ART UNIT 1743	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/742,803

Applicant(s)

MCLUEN ET AL.

Examiner

Dwayne K. Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30, 35-38, 40, 42 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30, 35-38, 40, 42 and 44-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 49 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 49 recites a cartridge for holding vials. Applicant had previously claimed the vial only.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 49 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 27-29, 35-38, 40, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823). This rejection was applied to claims 27-30, 35-38, 40, 42 and 44-48 in the previous Office Action (mailed 9/22/06). It remains in effect for claims 27-29, 35-38, 40, 42 and 44. Please see Response to Arguments below.

Art Unit: 1743

4. Claims 27-30, 35, 36, 38 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman et al. (5,240,680). This rejection was made in the previous Office Action (mailed 9/22/06). It remains in effect. Please see Response to Arguments below.

5. Claims 27-30, 35, 36, 38 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Cargill et al. (5,609,826). This rejection was made in the previous Office Action (mailed 9/22/06). It remains in effect. Please see Response to Arguments below.

Response to Arguments

6. The Examiner has removed the rejection of claims 30 and 45-48 under McGraw in response to Applicant's amending of those claims to recite a vial consisting essentially of a single frit.

7. Applicant has argued that McGraw fails to anticipate the instant claims because McGraw does not show teach a direct fit between the vial (column) and cartridge (bulkhead). See page 6, lines 14-22; page 7, lines 13-25, page 8, lines 14-20 and 25-30; p9, lines 3 and 19-27; page 10, lines 12-15; and page 11, lines 5-22. This argument is beyond the scope of the claims as written. As noted in the previous Office Action (paragraph 7); the vial of McGraw still meets this limitation (as do new references Zuckermann and Cargill). The claim as currently written does not include the hole of the

Art Unit: 1743

cartridge or even the cartridge. Applicant has not claimed the cartridge. Applicant has claimed a "having an exterior dimension to fit directly within a receiving hole of cartridge". Therefore, any vial that has an exterior dimension that allows it to fit directly in a hole will meet this limitation. Applicant is attempting to limit an element of the claimed device – an exterior dimension of the vial – by using another, unclaimed element – a cartridge hole. The Examiner submits that there is no structural limitation that is provided by this phrase. The vials/vessels of the prior art have a dimension that would allow them to fit directly into the receiving hole of a cartridge in a pressure tight seal. Therefore the vials of the references meet that limitation.

8. Applicant has argued that Zuckermann does not teach a solid support or the pressure tight seal. As noted above, the pressure tight seal is beyond the scope of the claim. The claim merely requires that the vial have an exterior dimension to fit directly in a receiving hole. This is what Zuckermann shows in Figure 3. The Examiner previously noted that Zuckermann does not show the solid support but their use is disclosed in columns 2 and 3.

9. Applicant has argued that Cargill does not teach a solid support or the pressure tight seal. As noted above, the pressure tight seal is beyond the scope of the claim. The claim merely requires that the vial have an exterior dimension to fit directly in a receiving hole. This is what Cargill shows in Figures 6-8. The Examiner previously

Art Unit: 1743

noted that Cargill does not show the solid support but their use is disclosed in column 2 and the end of column 7 (line 67).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
March 19, 2007


Jill Warden
Supervisory Patent Examiner
Technology Center 1700